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MAR 24 2006

In re Application of	:	OFFICE OF PETITIONS
Chiu et al.	:	
Application No. 10/708,284	:	DECISION
Filed: February 23, 2004	:	ON PETITION
Attorney Docket Number:	:	
REAP0014USA	:	

This is a decision on the Response to Petition Decision Made on 5/18/2005, filed June 6, 2005, requesting cancellation of the above-identified application and a refund of the application filing fees. The petition is properly treated under 37 CFR 1.181.

The petition is **dismissed**.

Background

The application was filed using the Electronic Filing System ("EFS"). Applicant asserts that an error occurred with the EFS server during filing of the above-identified application, such that the filing was incomplete. Applicant filed a petition requesting cancellation of the application and a refund of the filing fees on March 20, 2005. In support of the petition, Applicant provided a copy of what was putatively an error message he received when attempting to file the above-identified application. Applicant avers that he re-filed the same application two-days later, and the filing was successful as evidenced by his Acknowledgement Receipt, which included the application serial number, 10/708,327.

Three months later Applicant asserts that he received two filing receipts for the same application. A review of the error message that Applicant had filed in support of the petition

revealed that the error message was illegible - the image was too dark to read.

The petition was dismissed in a Decision mailed May 18, 2005. Applicant was advised to file a legible copy of the error message.

The instant petition

With the instant petition, Applicant has filed a legible copy of the error message.

A review of Office records reveals that, although the first filing generated an error message, the application was received in this Office and assigned the above-identified application number.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § 2 provides, in part, that:

The Commissioner...may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 41, Patent fees; patent and trademark search systems, states in pertinent part:

(a) The Director shall charge the following fees:

(1) (A) On filing each application for an original patent, except in design or plant cases, \$690¹.

35 USC § 42(d) provides that:

The Commissioner may refund any fee paid by mistake or any amount paid in excess of that required.

¹The application filing fee increased to \$770.00 at the time the above-identified application was filed. See 37 CFR 1.17. Applicant also submitted the fee for recordation of an assignment, \$40.00 under 37 CFR 1.21.

37 CFR 1.26(a) states in pertinent part that:

The Director may refund any fee paid by actual mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollars or less unless a refund is specifically requested, and will not notify the payer of such amounts.

OPINION

Request for Refund

The applicable statute, 35 USC 42(d), authorizes the Commissioner to refund "any fee paid by mistake or any amount paid in excess of that required." Thus, the patent and Trademark Office (PTO) may refund: (1) a fee paid when no fee is required (i.e., a fee paid by mistake), or (2) any fee paid in excess of the amount of the fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment). In the situation in which an applicant or patentee takes an action "by mistake" (e.g., files an application "by mistake"), the submission of fees required to take that action (e.g., a filing fee submitted with such application) is not a "fee paid by mistake" within the meaning of 35 U.S.C. § 42(d).

The Director is required, under 35 U.S.C. § 41, to charge an application filing fee. A review of the Office records reveals that the application was filed and processed in this Office, and an application serial number and filing date were accorded the application. Applicant submitted a filing fee and recordation of assignment fee, and received an application filing and a recorded assignment.

The applicable regulation, 37 CFR 1.26, requires that the money had to be paid by actual mistake, for a refund to be authorized. The mistake, however, must clearly be in relation to the payment itself in order to be refundable. Grady, supra. Here, the amount paid was owed at the time it was paid, and it was paid by the representative of the applicant. Such is not a mistake

within the meaning of the aforementioned statute and regulation that warrants a refund.

In this regard, there was no mistake relating to the payment itself. Petitioner is reminded that the use of "shall" appears in 35 USC § 41 pertaining to collection of fees upon the filing of an application with the PTO. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). That is, it is mandatory that the Director charge, and the applicant pay, the fees specified by statute upon presentation of a request for a service by the PTO. See BEC Pressure Controls Corp. v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (N.D. Ind. 1974). As such, the application and assignment recordation fees were due when such were submitted to the PTO on February 23, 2004, and were paid in the correct amount. Id. The language of the statute does not permit the Director any discretion with respect to charging the fees set forth therein. Id.

That Applicant may have presented the second application to the PTO does not warrant a finding that the payment was made "by mistake." Rather, the filing fee for the above-identified application was owed at the time it was paid. The payment of the fee automatically was due, by statute, when petitioner presented the aforementioned submission to the PTO for the filing of this application. Thus, it is immaterial to the question of "mistake" in payment of the instant application filing and recordation of assignment fees that petitioner may have re-submitted the fees to the PTO.

Petitioner requested that the filing fee be accepted for the filing of the application. The PTO is mandated by statute to collect the application filing fees. The subsequent re-filing of the application does not have the retroactive effect of making the previous payment an error or mistake. See Meissner v. U.S., 108 USPQ 6 (D.C. Cir. 1955) (appeal fee paid on same day that examiner allows the application is not a fee paid by mistake within the meaning of 35 USC 42(d)); see also Opinion of the Comptroller General of the United States, 113 USPQ 28, 29 (Comp. Gen. 1957). It follows that no refund is due.

Request for Cancellation of the above-identified application

Applicant requests cancellation of the above-identified application. A review of Office records reveals that an Office action was mailed on June 27, 2005. No response to the Office action having been filed, the application is abandoned for failing to timely and properly reply to the Office action. As such, cancellation of the application is a moot issue.

DECISION

In that Applicant has failed to establish the existence of a mistake in payment of the application filing fee within the meaning of the statute and regulation, no refund of the entire, or any fractional part thereof, is, or can be, authorized.

As the application is abandoned, cancellation of the application is moot.

Accordingly the petition is dismissed.

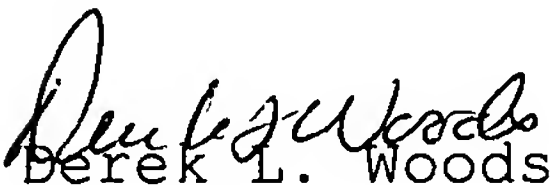
Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to the undersigned at (571) 272-3232.


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